

REMARKS

The Examiner is thanked for the thorough examination of the above-referenced patent application. The Office Action, however, has tentatively rejected all claims 12, 13, and 22. For at least the reasons set forth hereinbelow, Applicant respectfully request reconsideration of these rejections.

Discussion of Rejections Under 35 U.S.C 102(b)

Claims 12 and 13 stand rejected under 35 U.S.C. 102(b) as allegedly anticipated by Kao et al. (US 6,495,967). Applicant respectfully traverses the rejections for at least the reasons discussed below.

In short, Kao fails to teach or suggest one set of alignment marks installed on front and rear substrates as recited in claim 12.

In this regard, claim 12 recites:

12. A plasma display panel (PDP), comprising:
a front substrate; and
a rear substrate, wherein at least one set of alignment marks is installed on the front and rear substrates, the set of alignment marks comprise a first and second patterns installed on the predetermined assembling position of the first and second substrate respectively, *the second pattern comprises at least a hexagonal honeycomb pattern formed with rib barriers, a line segment of the first pattern is parallel to at least one side of the hexagonal honeycomb pattern with a predetermined distance therebetween, and the first and second patterns are used to align between the front and rear substrates, when assembling a PDP.*

(*Emphasis added.*) Claim 12 patently defines over Kao for at least the reason that Kao fails to disclose the features emphasized above.

As expressly recited, claim 12 defines a set of alignment marks comprising at least a hexagonal honeycomb pattern and at least one line segment installed on front and rear substrates,

respectively, to align therebetween. In contrast, Kao teaches a novel barrier wall configuration to increase coating area of phosphor layer and discharge cell space (see column 3, line 66 to column 4, line 27 and FIGS. 9 and 10). Clearly, Kao reference fails to disclose any alignment marks installed on front and rear substrates. Additionally, Kao discloses a plurality of parallel line segments across the honeycomb rib barrier 722, serving as transparent electrodes 111 of FIG. 2, which is used to apply voltage, as shown in FIG. 7. However, the first alignment pattern comprising at least one line segment of the invention is a dummy electrode, irrelevant to voltage application.

Accordingly, Applicant respectfully submits that the cited references fail to disclose all the limitations of claim 12. It is therefore the rejection of claim 12 should be withdrawn. Insofar as claims 13 and 22 depend from claim 12, these claims are also allowable. Further, insofar as claim 12 is allowable (without amendment), dependent claims 13-22 (including withdrawn claims) should be allowed.

As a separate and independent basis for the patentability of claim 22, Applicant respectfully traverses the rejections as failing to identify a proper basis for combining the cited references. The Office Action rejected claim 22 under 35 U.S.C. § 103(a) as allegedly unpatentable over Kao in view of Korean Publication 2002019353 (to Boo). In combining these references, the Office Action stated only that the combination would have been obvious “because it aids in providing a discharge sustain function... Additionally, since Kao and Boo are both from the same field of endeavor, the purpose disclosed by Boo would have been recognized in the pertinent art of Kao.” (Office Action, page 3). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive an alignment mark and plasma display panel, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

No fee is believed to be due in connection with this Response to Office Action. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to Deposit Account No. 20-0778.

Respectfully submitted ,

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